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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,807	07/28/2003	Michael Jarchau	7145	4551

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Attn: Maurice E. Gauthier
Samuels, Gauthier & Stevens LLP
Suite 3300
225 Franklin Street
Boston, MA 02110

EXAMINER

WALKER, ZAKIYA NICOLE

ART UNIT PAPER NUMBER

3672

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,807

Applicant(s)

JARCHAU ET AL.

Examiner

Zakiya N. Walker

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6 and 12-20 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 7-11 and 21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10302003</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.
2. Receipt is acknowledged of papers filed 7/28/03 based on an application filed in Germany on 9/17/01. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application under 35 U.S.C. 119(a)-(d). Instead, Applicant attempts to claim domestic priority of a PCT application under 35 U.S.C. 120, which is incorrect (see 35 U.S.C. 365(c)). A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the central nozzle and aperture of claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: Page 1, first sentence should be deleted. A U.S. application cannot be a "continuation" of an international application. Reference to a parent is only suggested for domestic priority benefits. If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. ____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the

application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims -3, 6, and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Clemens et al. (cited by applicant).

Clemens et al. discloses a jet cleaning tool that includes a device for cleaning an inner pipe which comprises: a nozzle head 10 comprised of a feed borehole 36 axially disposed therein, at least two rotation nozzles 18a, 18b, communicating with the feed borehole and extending perpendicularly from the longitudinal axis of the feed borehole, at least two cleaning nozzles 48 communicating with the feed borehole and extending downwardly at an angle from the longitudinal axis of the feed borehole, and a shaft 16; a rinsing nozzle 108 communicating with the feed borehole and extending upwardly at an angle from the longitudinal axis of the feed borehole; and an outer sleeve 14 adapted to receive a hollow rod (in phantom), the shaft being received in the outer sleeve whereby when the device is inserted into an inner pipe and a medium is flowed through the feed borehole and out of the rotation nozzles a force is generated as the medium emerging from the rotation nozzles contacts the wall of the inner pipe which force causes the nozzle head to rotate, the outer sleeve comprising a first means 26 for preventing the nozzle head from descending into the inner pipe disjoined from the outer sleeve when the nozzle head has a first break, the cross-section of which lies above the

first means for preventing and a second means 24 for preventing the nozzle head from descending into the inner pipe disjoined from the outer sleeve when the nozzle head has a second break, the cross-section of which lies above the second means for preventing.

The reference further teaches: a first and second radial bearing 28 and a first and second axial bearing 30, the bearings being disposed between the shaft and the outer sleeve; wherein the radial bearings are cylindrical; wherein the nozzle head further comprises at least one water outlet 106 in communication with the feed borehole and positioned upwardly from the longitudinal axis of the feed borehole, and a gap 40 formed in between the water outlet and the outer sleeve, the gap being filled with medium when the medium is flowed through the feed borehole and emerges out of the water outlet; wherein the shaft comprises a first part 12 and a second part 16, the first part being received in the second part and being constructed and arranged to allow axial movement of the second part within the first part and to prevent rotational movement of the second part within the first part; wherein the shaft further comprises a damping chamber 40 in communication with a chamber 36, the damping chamber communicating with the chamber through a damping gap 38; wherein the bearings are comprised of stainless steel, the bearings being adapted to be cooled by a medium when the medium is provided between the nozzle head and the outer sleeve; wherein the nozzle head further comprises an aperture, a recess 98 having a top end, a plunger 72 comprised of a base and a tip and disposed within the recess, and means 70 for biasing the plunger in a first position wherein the tip extends through the aperture and

outwardly from the nozzle head; wherein the nozzle head further comprises a spring 70 having a first end and a second end, the first end contacting the base and the second end contacting the top end whereby when a force is applied to the tip and the plunger is in the first position, the spring compresses allowing the plunger to move upwardly within the recess to a second position; wherein the plunger is concentrically disposed within the nozzle head; wherein the nozzle head further comprises at least two jet nozzles 52 positioned within the nozzle head, the jet nozzles being in communication with the feed borehole when the plunger is in the second position thereby allowing the emergence of medium out of the jet nozzles when the medium is flowed through the borehole and being out of communication with the feed borehole when the plunger is in the first position thereby preventing the emergence of medium out of the jet nozzles when the medium is flowed through the borehole; wherein the plunger further comprises a plurality of channel boreholes 54 so constructed and arranged to allow the flow of medium through the channel boreholes to the rotation nozzles or optionally the cleaning nozzles or optionally the rotation nozzles and the cleaning nozzles when the medium is flowed through the feed borehole and the plunger is in the first position; and wherein the channel boreholes are constructed and arranged to prevent the flow of medium through the channel boreholes to the rotation nozzles or optionally the cleaning nozzles or optionally the rotation nozzles and the cleaning nozzles when the medium is flowed through the feed borehole and the plunger is in the second position.

Allowable Subject Matter

7. Claims 4, 5, 7-11, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zink and Sawade et al. teach cleaning devices with rotating nozzles and/or magnetic brakes.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (703) 305-0302. The examiner can normally be reached on Tuesday-Friday, 6:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3672

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Zakiya N. Walker
Primary Examiner
Art Unit 3672

ZW
April 2, 2004